

REMARKS

Claim rejections under 35 USC 103

Claims 1, 4-9, 11, and 12 have been rejected under 35 USC 103(a) as being unpatentable over Poppenga (2003/0120624) in view of Kaplan (6,594,674), in view of Maxell (6,567,860), in view of Smith (2002/0069353), and in view of official notice. Claims 2 and 3 have been rejected under 35 USC 103(a) as being unpatentable over Poppenga in view of Kaplan, Maxwell, Smith, and official notice, and further in view of Barmettler (2003/0023770). Claims 10 and 13 have been rejected under 35 USC 103(a) as being unpatentable over Poppenga in view of Kaplan, Maxwell, Smith, and official notice, and further in view of Platt (5,421,009). Claim 14 has been rejected under 35 USC 103(a) as being unpatentable over Poppenga in view of Kaplan, Maxwell, Smith, official notice, and Platt, and further in view of Barmettler.

Claims 1 and 13 are independent claims, from which the remaining pending claims ultimately depend. Applicant respectfully submits that claims 1 and 13 at least as amended are patentable over the prior art in combination, such that the remaining pending claims are patentable at least because they depend from patentable base independent claims. Applicant now discusses three separate reasons why claims 1 and 13 at least as amended are patentable over the prior art in combination. In these discussions, claim 1 is discussed as representative of both claims 1 and 13 insofar as the present rejections are concerned.

First reason why claimed invention is patentable

The claimed invention recites “creating *references* within an unattended installation file for the client computing system *to the entries* for the drivers of the devices for the client computing system *within the master driver file*.” That is, *references* to the entries within the master driver file are *created within the unattended installation file*. Applicant notes that the terminology “reference” is relevantly defined by the Internet web site www.wikipedia.org as “an object

containing information which refers to data stored elsewhere, as opposed to containing the data itself” (see en.wikipedia.org/wiki/Dereference). This, in the claimed invention the reference created within the unattended installation file is an object that refers to the data (i.e., the driver entry) stored elsewhere (i.e., within the master driver file), as opposed to this data/driver entry being stored within the unattended installation file itself.

Applicant respectfully submits that the cited prior art in combination does not suggest this aspect of the invention as previously presented. The Examiner has indicated that the cited prior art in combination suggests this inventive aspect in paragraph [0032], lines 1-12, of Poppenga (see final office action, p. 3, ll. 2-3). However, in this paragraph, a “driver package builder 34 retrieves the initially selected from the device driver database 30 and automatically generates an appropriate accompanying configuration file o[r] files . . . to accompany the driver installation” such that the “automatically selected driver and accompanying configuration files are made available to the customer 20 via the MPP website 18 for automatic downloading, installation, and configuration.”

It is thus readily apparent that no *reference* is created within the unattended installation file to an *entry* for a driver file *within the master driver file* in the cited prior art in combination. The driver file *itself* is retrieved from the device driver database 30, the latter which presumably corresponds to the master driver file of the invention. As such, no reference is created to an *entry* within the database 30, but rather the entire driver file is *itself* retrieved in the cited prior art in combination. For instance, the configuration files do not have any *reference* created within them *to an entry* for a driver *within the database 30*, rather, at best, the configuration files refer to the *driver file itself* – and not to the *entry* for the driver file, as in the claimed invention.

Stated another way, in the claimed invention you create an entry within a master driver file, and then you create a reference within an unattended installation file to this entry within the master driver file. By comparison, in the cited prior art in combination, you retrieve a driver file from the master driver file, and then you may create a reference within the configuration file to

this driver file itself. You do not create a *reference within the configuration file to an entry within the master driver file* in the cited prior art in combination (where this entry is for a driver file), in contradistinction to the claimed invention. Indeed, it would not make sense to do so, since the cited prior art in combination *retrieves the entire driver file* from the master driver file, and the driver file is passed to the client computing system; that is, if you are passing the entire driver file to the client computing system, then you do not have to create any reference to an entry for this driver file as stored in the master drive file, because you *already have* the driver file and can reference it directly. Compare this situation to the invention, in which you just create a reference to an *entry* for the driver file within the master driver file.

For just this reason, the claimed invention is *prima facie* nonobvious and patentable over the cited prior art in combination.

Second reason why claimed invention is patentable

The claimed invention recites that “determining which drivers are needed for devices on the client computing systems that are not automatically found and installed during vendor-specified operating system installation,” “creating entries for the drivers within a master driver file,” and “for each client computing system, creating references within an unattended installation file to the entries for the drivers within the master driver file” are all performed *by a server computing system responsible for installing operating systems on the client computing systems* (see patent application as filed, p. 8, ll. 18-19; p. 10, ll. 15-16; p. 11, ll. 1-2; and p. 12, ll. 3-6). That is, it is not just any server computing system that performs this functionality, but rather the server computing system that is responsible for installing operating systems on the client computing systems that performs this functionality.

Applicant respectfully submits that the cited prior art in combination does not suggest this aspect of the invention as amended. The Examiner has particularly relied upon Maxwell as suggesting that a server computing system is responsible for installing operating systems on client

computing systems in rejecting the claimed invention over the cited prior art in combination. However, Maxwell does not disclose this. The passage of Maxwell relied by the Examiner, for instance, merely states that “[a] method and apparatus are disclosed for inputting new device driver information into a Personal Computer (PC) in an existing computer network so as to enable the Operating System (OS) to recognize the new hardware device during installation of the OS and to permit the OS to automatically install the associated device driver” (col. 4, ll. 1-8). There is no discussion here of a server computing system being responsible for installing operating systems on client computing systems; Maxwell simply discloses that device drivers are input into a PC so that during installation of the OS the OS can automatically install the device drivers. Thus, even under the Examiner’s proffered interpretation of the prior art in combination, the claimed invention is not suggested by this combination of the prior art.

In fact, the base reference Poppenga actually teaches away from the servers being responsible for installing operating systems on the client computing systems. This is because the client computing system 20 interacts with the servers 12/14 over a web site 18 (see, e.g., Poppenga, paras. [0027]-[0032]). However, if an operating system is not yet installed on the client computing system 20 (i.e., such that the servers 12/14 are responsible for installing the operating system on the client computing system 20 as in the invention), then there is no way for the client computing system 20 to communicate with the servers 12/14 over the web site 18. Thus, the servers 12/14 cannot be responsible for installing an operating system on the client computing system 20 if the servers 12/14 cannot communicate with the client computing system 20 prior to the operating system being installed on the client computing system 20. That is, communication between the client computing system 20 with the servers 12/14 over the web site 18 requires that an operating system already has been installed on the client computing system 20. Therefore, the servers 12/14 communicate with the client computing system 20 over the web site 18 after the operating system has already been installed on the client computing system 20, and

thus cannot be responsible for installing the operating system on the client computing system 20, as in the claimed invention.

In *KSR Int'l Co. v. Teleflex, Inc.*, 550 US 298 (2007), the Supreme Court stated that “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is likely to be nonobvious” (KSR, slip opinion at 12), referring to its earlier decision *United States v. Adams*, 383 US 39 (1966). That is the case here. The base reference Poppenga teaches away from installation of operating systems on client computing systems. The reference that the Examiner specifically relies upon as teaching this aspect of the invention, Maxwell, does not cure this defect; indeed, it is completely silent as to this aspect of the invention. Therefore, the prior art in combination does not suggest the claimed invention – being silent as to one of the aspects of the invention – and indeed teaches away from the claimed invention, such that the invention is not *prima facie* obvious and unpatentable for these reasons as well.

Third reason why claimed invention is patentable

The claimed invention is limited such that the server computing system creates entries for the drivers within a master driver file *without user interaction*. That is, the creation of the entries within the master driver file is performed by the server computing system *without user interaction*. For instance, in the patent application as filed, the server computing system 102 determines which of these drivers are needed, as described on page 10, lines 15-22. Thereafter, the server computing system 102 creates the entries for these drivers, as described on page 11, lines 1-15. This process is part of an “unattended” operating installation process provided by the invention, as described on page 6, lines 1-22. This process is thus advantageous over prior art processes requiring “manual” installation, as described on page 4, lines 5-14. Therefore, the server computing system creating entries for the drivers within the master driver file *without user interaction* is inherent within the patent application as filed.

Applicant respectfully submits that the prior art in combination does not suggest this aspect of the invention, and indeed teaches away from this aspect of the invention. The Examiner has indicated that the prior art in combination suggests the creation of entries for drivers within a master driver file in paragraph [0030] of Poppenga (see final office action, p. 3, ll. 2-3). It is noted that in this paragraph, a “customer obtains the asset number of the desired printer 26 either by a search of the MPP website 18 or via visual inspection of an identification tag on the desired printer 26,” such that “the customer selects or enters the printer asset number into an appropriate field of the MPP website 18 to initiate automatic driver selection, downloading, installation, and configuring.” As such, it cannot be said that the creation of driver entries within a master driver file is performed in the prior art in combination *without user interaction* as in the claimed invention. Rather, Poppenga teaches away from this aspect of the invention, in that a customer (i.e., a user) has to obtain an asset number of the desired printer, where this asset number that is user-obtained permits a corresponding driver entry to be created.

Now, the Examiner has stated that Maxwell and Smith suggest the lack of user interaction in correspondence with the claimed invention. However, such recitation of Maxwell and Smith ignores the basic fact that Poppenga itself teaches away from the claimed invention. The “nature of the teaching [of the prior art] is highly relevant” in determining obviousness (MPEP sec. 2145.X.D.1), and that the “prior art must be considered in its entirety, including disclosures that teach away from the claims” (MPEP sec. 2143.02.VI). Therefore, it is not enough that the Examiner has seemingly provided references suggesting lack of user interaction in correspondence with the claimed invention to show obviousness – the Examiner has failed to consider the entirety of the base reference Poppenga, which teaches away from combination with Maxwell and Smith.

Furthermore, Maxwell and Smith do not actually suggest *the server computing system creating entries for the drivers within the master driver file without user interaction*, which is the entire limitation of the claimed invention that is the subject of this inquiry. As to Maxwell, the Examiner says that because column 3, lines 15-19 thereof state that “[t]he method claimed may

also include steps wherein . . . a special graphical user interface (GUI) [is] displayed,” that this necessarily means that such user interaction/GUI is not *required* (p. 4 of final office action). This line of reasoning is suspect in a number of ways.

First, the Examiner confuses that Maxwell states that the “*claimed method*” *may* include user interaction; however, the issue as to what Maxwell does and does not disclose or suggest is not what is claimed, but what it actually discloses or suggests. In this respect, Maxwell discloses and suggests user interaction in the way of a GUI – just because its *claimed method* may not be limited to such user interaction does not mean that Maxwell *itself suggests* such lack of user interaction as in the invention. Maxwell simply does not disclose or suggest a lack of user interaction as in the invention; that is to say, the fact that Maxwell claims a method that is not necessarily limited to user interaction does not mean that it discloses or suggests this.

Second, the Examiner has interpreted that Maxwell’s recitation that “the method claimed may include . . . a special graphical user interface (GUI)” as meaning that Maxwell does not require a GUI is just *one* interpretation of this passage, which is not guided by Maxwell itself, but rather is informed solely by the claimed invention. For example, it is just as reasonable to conclude that Maxwell implies that a GUI is required, but that a *special* GUI is claimed in one particular method thereof, such that other embodiments may merely use a *standard, non-special* GUI, for instance. The only reason that the Examiner has interpreted Maxwell as he has done to say that this passage of Maxwell implies that a GUI is not required in other embodiments is that this is what the claimed invention requires – not what Maxwell actually suggests. However, one cannot use hindsight reconstruction to pick and choose among the prior art to deprecate the claimed invention (In re Fritch, 972 F.2d 1260 (Fed Cir. 1992)).

Third, and perhaps most importantly, the Examiner has considered the claim limitation “without user interaction” in isolation. However, the claimed invention has to be considered as a whole – the relevant inquiry here is thus whether the Maxwell suggests “the server computing system creating entries for the drivers within the master driver file *without user interaction*,” and

“without user interaction” by itself. The claimed invention is to be considered “as a whole” (MPEP sec. 2141.02.I.), taking into account all the claim language of the claim. “All words in a claim must be considered in judging the patentability of that claim against the prior art” (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). As noted above, the base reference Poppenga is relied upon by the Examiner as suggesting the creation of entries for drivers within a driver file – however, as also noted above, Poppenga creates such entries *with* user interaction, and not *without* user interaction. The fact that Maxwell may *at best* suggest no user interaction to perform something else entirely (i.e., other than creating driver entries within a driver file) does not mean that the resulting combination of Poppenga, Maxwell, and the other prior art rises to the level of suggesting the entirety of this claim limitation.

That is, the Examiner has to show how the prior art suggests the server computing system creates driver entries without user interaction. However, what the prior art the Examiner relies upon actually suggests is that the server computing system creates driver entries *with* user interaction (per Poppenga), and that there is *no* user interaction as to something else entirely (per Maxwell). One of ordinary skill within the art thus would not be prompted to combine these references to yield the claimed invention. Rather, one of ordinary skill within the art would be led to combine these references such that the server computing system creates driver entries with user interaction (per Poppenga), and performs something else entirely without user interaction (per Maxwell).

Finally, as to Smith, the Examiner has also stated that this reference suggests in paragraph [0013] the claim limitation in question. However, Smith simply discloses in this paragraph that a “configuration information file containing data [is] used by a computer system to automatically install a first device driver and allocate computer system resources without user interaction.” This is not what the claimed invention is limited to. Applicant is not claiming the automatic installation of a device driver without user interaction, but rather the creation of driver entries by a server computing system within a driver file without user interaction – something completely different.

Again, the Examiner has not shown how the prior art suggests what the claimed invention is actually limited to. The prior art the Examiner actually relies upon, Poppenga, to suggest a server computing system creating driver entries does so with user interaction, not without user interaction. The fact that other prior art, Smith, does something completely different without user interaction does not change this fact. As is the case with Maxwell, one of ordinary skill within the art would be led to combine these references such that the server computing system creates driver entries with user interaction (per Poppenga), and performs something else entirely without user interaction (per Smith). For all of these reasons as well, then, the claimed invention is not *prima facie* obvious and unpatentable over the cited prior art in combination.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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